

Appl. No. 10/733,058
Amendment Dated June 25, 2008
Reply to Office Action of June 2, 2008

REMARKS

New claims 25 - 34 have been added in order to alternately define the invention as disclosed in the specification. Applicants note that new independent claims 26 and 30 include all of the limitations of claim 11, would not impose a search burden on the Examiner, and thus are not subject to restriction.

Without conceding the propriety of the Examiner's position, and solely to expedite prosecution, claims 6, 9, 14, and 17 - 24 have been cancelled without prejudice or disclaimer.

Applicants respectfully request reconsideration of the Examiner's rejection of claims 7 - 8, 10 - 13, and 15 - 16 under 35 U.S.C. §102(b). The Examiner has rejected these claims in view of the cited reference of *Avery et al.* (U.S. Patent No. 2,391,539). The *Avery* reference is directed to a method of making pressure sensitive labels. (See the Abstract of the reference). The Examiner cites Fig.'s 1 and 2 and Col. 2 as disclosing Applicant's currently claimed invention.

Applicants respectfully submit that *Avery* fails to disclose the currently claimed invention in Fig.'s 1 and 2 and Col. 2.

Applicants note that the Court of Appeals for the Federal Circuit has held that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that the cited portions of the *Avery* reference fails to anticipate each and every element of the currently claimed invention.

Applicants note that claim 7 is directed to a roll-shaped printing medium, in which a printing layer is adhered to a release layer and, together, rolled into a roll-shaped printing medium as shown in Fig.'s 11 and 12 of Applicant's disclosure. The only point in which *Avery* discloses a

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printing medium (which includes a printing layer and a release layer adhered via adhesive) is in the portion of Fig. 1 between the rolls 11 and 12 and to the left of the rolls in the direction of travel of the label sheet. At any point to the right of the rolls 11 and 12 in Fig. 1 of Avery, there is no printing medium as the term is defined in Applicant's claims and specification, as there is no combination of printing layer and release layer adhesively combined.

Accordingly, the webs 10 and 15 cited by the Examiner are not roll-shaped printing mediums. Rather, they are only separate planar webs including, respectively, a top layer 10 and a release layer 15. Col. 2, lines 31 – 37, cited by the Examiner, discloses only the storage of separate rolls of top layer 10 and bottom layer 15.

Furthermore, Applicants note that claim 7 requires that the longitudinal cuts exist in the printing layer while the layers are rolled together in a spiral shape. Avery, on the other hand, discloses the longitudinal cutting of the printing layer 10 via the blade cutter 25 only after the top layer 10 is unrolled from its roll-shaped storage supply.

For at least these reasons, Applicants submit that the Examiner's rejection of claims 7 – 8, 10, and 15 should be withdrawn, and these claims placed in condition for allowance.

In regard to claims 11 – 13 and 16, Applicants submit that the Avery reference fails to disclose the formation of an image in an image-forming portion of the printing medium.

For at least this reason, Applicants submit that the Examiner's rejection should be withdrawn, and claims 11 – 13 and 16 should be placed in condition for allowance.

In specific regard to claims 15 and 16, Applicants submit that the Avery reference fails to disclose that the longitudinal cuts are formed at least partially into the release layer, but not all the way through the release layer.

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For at least this reason, Applicants submit that the Examiner's rejection should be withdrawn, and claims 15 and 16 should be placed in condition for allowance.

Applicants submit that the prior art references of record, whether considered alone, or in combination, fail to provide any teaching or suggestion whatsoever regarding this advance in the art. In light of the foregoing, Applicants submit that all claims now stand in condition for allowance.

In the event that it is deemed necessary, the Commissioner is hereby authorized to charge any fees due or to credit any overpayment to Deposit Account No. 50-3891.

Respectfully submitted,

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